

REMARKS

Claims 53-112 are currently pending.

In the Office Action, the Examiner requires that the claims be restricted to one of the following two groups:

- I. Claims 53-93 and 106-112, drawn to optical fiber device/method; and
- II. Claims 94-105, drawn to a radiation curable composition.

See Mar. 4, 2009, Office Action at 2.

Applicants respectfully traverse this restriction requirement. However, to be fully responsive, Applicants elect the subject matter of Group I, comprising claims 53-93 and 106-112. Applicants reserve the right to pursue the unelected subject matter in divisional applications.

The Examiner asserts that the “[i]nventions II and I are related as mutually exclusive species in an intermediate-final product relationship.” *Id.* Citing M.P.E.P. § 806.05(j), the Examiner states that “[d]istinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct.” *Id.* The Examiner concludes that “the intermediate product is deemed to be useful as a curable composition used on other surfaces such as, e.g., a flat substrate and the inventions are deemed patentably distinct because there is nothing of record to show them to be obvious variants.” *Id.*

Applicants submit that the Examiner has not established a proper basis for the Restriction Requirement. Applicants respectfully refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs the Examiner as follows:

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining Groups I and II together would constitute a serious burden. The Examiner does not specify what serious burden will be placed on the Examiner if the Examiner were to proceed in examining Groups I and II together, as required by M.P.E.P. § 803.

Additionally, Applicants submit no serious burden would exist in light of the requirement of rejoinder. See M.P.E.P. § 821.04. Thus, it is unclear what burden is on the Examiner to examine the claims of Groups I and II together, and Applicants respectfully request withdrawal of the restriction requirement.

Because Group I is elected, the Examiner additionally requires election of a single “species” from the following:

Species A - drawn to an optical fiber device/method with a coating comprising an ethylenically unsaturated polyurethane; and

Species B - drawn to an optical fiber device/method having a coating/method-of-using-said-coating that may not have at least one ethylenically unsaturated polyurethane.

See Mar. 3, 2009, Office Action at 4.

The Examiner asserts that the “above species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.” *Id.*

Applicants respectfully traverse this election requirement. Nevertheless, to be fully responsive, Applicants elect, with traverse, “Species A.”

The Examiner asks for a listing of all claims “readable” on the election of species.

Id. at 3. Applicants note that at least elected claims 53-93 and 106-112 are readable thereon.

Applicants respectfully traverse the election of “species” requirement, at least because there is no request to elect a species. Rather than asking Applicants to elect between different specific coating compositions, the Examiner has requested an “election” between compositions comprising an ethylenically unsaturated polyurethane and those that may not. Since none of the claims of Group I preclude an ethylenically unsaturated polyurethane, all of the optical fiber device/method claims having a coating/method-of-using-said-coating that may have at least one ethylenically unsaturated polyurethane.

To the extent there may have been a distinction between the “species,” the Examiner, similar to the Restriction Requirement, failed to show that a serious burden exists to examine all of the alleged species. To make a proper requirement for an election of species the Examiner must, *inter alia*, show that the search and examination of a claim would impose a serious burden on the Office because it embraces an unreasonable number of species. See M.P.E.P. § 803.02. Here, the Examiner has provided no reasons or evidence on the record to substantiate the election of species requirement, let alone how examination of all the species would impose a serious burden.

If the Examiner chooses to maintain the election of species requirement, Applicants expect the Examiner, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to

determine the patentability thereof, *i.e.*, extending the search to a “reasonable” number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

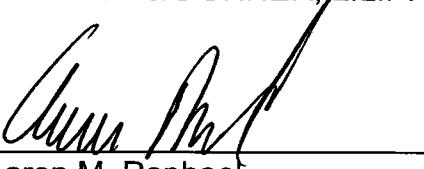
If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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